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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,925	09/16/2003	Michael E. Benz	P-10908.00	2297
26813	7590	05/25/2006		EXAMINER
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,925	BENZ ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 3/8/06 Amendment.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.  
 4a) Of the above claim(s) 18-34, 37-40 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17, 35-36 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/8/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

1. The Applicants' amendment filed on March 8, 2006 is acknowledged.

Claim 12 is amended. Claims 18-34 and 37-40 are withdrawn. Now, Claims 1-17 and 35-36 are pending for consideration.

2. Claim objection(s) in the previous Office Action (Paper No. 121005) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Claim Rejections - 35 USC § 102 and 103***

5. Rejection of Claims 1-17 and 35-36 under 35 USC 102(b) as being anticipated by Gunatillake327 (WO 99/50327, US 6 437 073) and Rejection of Claims 1-17 and 35-36 under 35 USC 102(b) as being anticipated by Gunatillake863 (WO 99/03863, US 6 420 452) are maintained because the rejection is adequately set forth in paragraphs 5-6 of Paper No. 121005. Applicant's

arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 9, last paragraph to page 10, 2<sup>nd</sup> paragraph), it is noted that the word "soft" in the present invention is a relative term. Although in the previous Office action (paragraph 5), Examiner states that the extenders containing arylene groups inherently impart hard segments to the polyurethane. However, the particular hard segments mentioned are relative hard segments as compared to those extenders containing C1-C12 alkylene radicals. At any rate, Gunatillake327's and Gunatillake863's chain extenders read on the formulae set forth in the present invention, they should be **as soft as** those segments claimed in the instant claims.

6. Rejection of Claims 1-12, 14-15, 17 and 35-36 under 35 USC 102(b) as being anticipated by and rejection of 11-12 under 35 USC 103(a) as being unpatentable over Zdrahala (US 4 647 643) are maintained because the rejections are adequately set forth in paragraphs 7 and 11 of Paper No. 121005. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 10, last paragraph bridging to page 11, 1<sup>st</sup> paragraph and page 11, last paragraph), note that W can be an alkylene bridge of from 1 to 4 carbon atoms or an arylene group. (col. 3, line 63 to col. 4, line 3)

5. Rejection of Claims 35-36 under 35 USC 102(b) as being anticipated by Gunatillake971 (WO 00/64971, US 2002/0028901) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 121005. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 11, 2<sup>nd</sup> paragraph), as mentioned in the previous Office action, R7 in formula (I) ([0008]) can be described in [0012] and [0024]-[0025]. Since Gunatillake971's formula (I) reads on the formulae set forth in the present invention, it should be **as soft as** those segments claimed in the instant claims. Although Gunatillake971 teaches the use of amine-terminated PDMS in Examples, this is merely a preferred embodiment. Certainly, Gunatillake971 does not teach away the use of a compound represented by formula (I) where R7 is described in [0021] and [0024]-[0025].

6. Rejection of Claim 35 under 35 USC 102(b) as being anticipated by Iwahara (EP 661 332) is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 121005. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 11, 3<sup>rd</sup> paragraph), as mentioned in the previous Office action, Iwahara discloses a polymer containing at least one structure unit selected from the group consisting of formula (1), formula (2) and formula (3) (i.e., carbosilane units). (page 3, lines 6-30 and Examples) Note that these structure units read on the formulae (i.e., carbosilane units) set forth in the present invention, they should be as soft as those segments claimed in the instant claim.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

May 18, 2006

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712